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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,805	03/09/2000	DAVID LEIGH DONOHO	UNIV0001D6	2848

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EXAMINER

FRENEL, VANEL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/521,805

Applicant(s)

DONOHO ET AL.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Affidavit of Declaration pursuant to 37 CFR 1.131 filed on 01/21/04. Claims 1-38 are pending.

Claim Rejections - 35 USC 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 15, 20, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (6,029,195), Basche (6,119,164), Pant et al (6,012,053) in view of Grasso et al (5,892,909).

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(A) As per claim 1, Herz discloses an advice provider which broadcasts information over a communications medium to a third party to target information of interest to consumers (See Herz, Col.1, lines 18-42); and wherein said advice provider offers highly targeted advice without compromising individual privacy (See Herz, Col.5, lines 21-52); In a system including an advice consumer for gathering broadcast information from a communications medium, a communications system (See Basche, Col.1, lines 6-32; Col.2, lines 25-64).

The combination of Herz, Basche and Pant does not explicitly disclose wherein said advice consumer "is resident on a client system" and is advised of said information "by a reader" if said information meets certain predetermined relevance criteria; a reader resident with said advice consumer that determines relevance of said broadcast information.

However, these features are known in the art, as evidenced by Grasso. In particular, Grasso suggests wherein said advice consumer "is resident on a client system" and is advised of said information "by a reader" if said information meets certain predetermined relevance criteria; a reader resident with said advice consumer that determines relevance of said broadcast information (See Grasso, Col.2, lines 13-53; Col.26, lines 1-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Grasso within the collective teachings of Herz,

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Basche and Pant with the motivation of providing a co-active information delivery system which provides a practical solution to information delivery and, at the same time, does not require an entire company or community to adopt the same work practices and software and communications standards (See Grasso, Col.4, lines 55-63).

(B) As per claim 15, Herz discloses a method for remotely and anonymously inspecting one or more communicating devices for information of interest to information consumers (Col.33, lines 3-59; Col. 34, lines 47-67 to Col.35, line 45) said method comprising the steps of:

providing a third party consumer database inspector which is installed on a third party computer for determining if said information is relevant to any individuals in a consumer database (See Herz, Col.1, lines 18-42);

using relevance evaluation to generate queries to said third party consumer database inspector (See Herz, Col.30, lines 3-67 to Col.31, line 35); and

providing relevant messages from said third party to appropriate consumers to advise said consumers of relevant information (See Herz, Col.30, lines 3-67 to Col.31, line 35);

said third party computer gathering advisories routinely from an advice provider which broadcasts information over a communications medium to one or more third parties to target information of interest to consumers (See Basche, Col.1, lines 6-32).

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The combination of Herz, Basche and Pant does not explicitly disclose "wherein said advisories contain a relevance clause component that is written in a formal relevance language precisely specifying the conditions under which an advisory could be relevant".

However, this feature is known in the art, as evidenced by Grasso. In particular, Grasso suggests "wherein said advisories contain a relevance clause component that is written in a formal relevance language precisely specifying the conditions under which an advisory could be relevant" (See Grasso, Col.29, lines 21-67 to Col.30, line 67; Col.32, lines 1-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Grasso within the collective teachings of Herz, Basche and Pant with the motivation of providing a co-active information delivery system which provides a practical solution to information delivery and, at the same time, does not require an entire company or community to adopt the same work practices and software and communications standards (See Grasso, Col.4, lines 55-63).

(C) Claim 20 differs from claims 1 and 15 by reciting the steps of providing one or more advice providers.

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As per this limitation, it is noted that Herz discloses an advice provider which broadcasts information over a communications medium to a third party to target information of interest to consumers (See Herz, Col.1, lines 18-42);

advising said advice consumer of said information by a reader if said information meets certain predetermined relevance criteria (See Herz, Col.3, lines 1-10); In a system including an advice consumer for gathering broadcast information from a communications medium, a communications method (See Basche, Col.1, lines 6-32; Col.2, lines 25-64); said advice provider offering highly targeted advice without compromising individual privacy (See Herz, Col.37, lines 64-67 to Col.38, line 46); providing a reader resident with said advice consumer that determines relevance of said broadcast information (See Pant, Col.2, lines 25-54; Col.12, lines 41-59) and Grasso discloses "wherein said advice consumer is resident on a client system" (See Grasso, Col.2, lines 13-53; Col.26, lines 1-67).

Thus, it is readily apparent that these prior art systems utilize providing advice providers to perform their specific function.

The remainder of claim 20 is rejected for the same reason given above for claims 1 and 15, and incorporated herein.

(D) As per claim 34, Herz discloses a method for remotely and anonymously inspecting one or more communicating devices for information of interest to information

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consumers (See Herz, Col.33, lines 3-59; Col. 34, lines 47-67 to Col.35, line 45) said method comprising the steps of:

providing a third party consumer database inspector which is installed on a third party computer for determining if said information is relevant to any individuals in a consumer database (See Herz, Col.1, lines 18-42);

a relevance evaluation module for generating queries to said third party consumer database inspector (See Herz, Col.30, lines 3-67 to Col.31, line 35); and

said third party consumer database inspector including a module for quering said consumer database (See Pant, Col.3, lines 10-67);

means for providing relevant messages from said third party to appropriate consumers to advise said consumers of relevant information (See Herz, Col.30, lines 3-67 to Col.31, line 35);

said third party computer including a module for gathering advisories routinely from an advice provider which broadcasts information over a communications medium to one or more third parties to target information of interest to consumers (See Basche, Col.1, lines 6-32).

The combination of Herz, Basche and Pant does not explicitly disclose "wherein said advisories contain a relevance clause component that is written in a formal relevance language precisely specifying the conditions under which an advisory could be relevant".

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However, this feature is known in the art, as evidenced by Grasso. In particular, Grasso suggests "wherein said advisories contain a relevance clause component that is written in a formal relevance language precisely specifying the conditions under which an advisory could be relevant" (See Grasso, Col.29, lines 21-67 to Col.30, line 67; Col.32, lines 1-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Grasso within the collective teachings of Herz, Basche and Pant with the motivation of providing a co-active information delivery system which provides a practical solution to information delivery and, at the same time, does not require an entire company or community to adopt the same work practices and software and communications standards (See Grasso, Col.4, lines 55-63).

4. Claims 2, 16, 21, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (6,029,195) in view of Basche (6,119,164) as applied to claim 1 above, and further in view of Ellesson et al (6,098,099).

(A) As per claims 2, 21, and 35, Herz discloses the system wherein said information of interest to consumers (Col.3, lines 1-10).

The combination of Herz and Basche do not explicitly disclose any consumer product warnings, recalls, and safety advisories. However, this feature is known in the art, as evidenced by Ellesson.

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In particular, Ellesson teaches any consumer product warnings, recalls, and safety advisories (Col.5, lines 1-9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Ellesson within the combination of Herz and Basche with the motivation of providing a directory database which allows data items or entries stored therein to be marked for third-party notification (Col.3, lines 63-65).

(B) Method claim 16, repeats the subject matter of claim 2 and respectively as a set of means- plus-function elements rather than a series of steps. As underlying processes of claim 16, has been shown to be obvious in view of the collective teachings of Herz and Basche, it is readily apparent that the system disclosed by the applied prior art performs the recited underlying functions. As such, the limitation recited in claims 16 is rejected for the same reasons given above for system claim 2, and incorporated herein.

5. Claims 3-14, 17-19, 22-33, and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (6,029,195) in view of Basche (6,119,164), Ellesson et al (6,098,099) as applied to claims 1-2 above, and further in view of Tarter et al (5,704,044).

(A) As per claim 3, Herz, Basche and Ellesson disclose the system wherein said consumer product warning (See Ellesson Col.1, lines 13-21).

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The combination of Herz, Basche and Ellesson do not explicitly disclose information concerning drug products and their interactions.

However, this feature is known in the art, as evidenced by Tarter. In particular, Tarter teaches the use of information concerning drug products and their interactions (See Tarter Col.2, lines 27-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Tarter within the combination of Herz, Basche and Ellesson with the motivation of providing pharmacies with the capability of using their current computer system and their access to the on-line adjudication network to obtain, in some instances overnight payment for insurance claims arising from the provision of healthcare services to their customers (See Tarter Col.9, lines 30-35).

(B) As per claim 4, Tarter discloses the system wherein said third party is a pharmacy (Col.1, line 47); and wherein said advice provider comprises an advice site which operates to notify pharmacies about potentially damaging drug interactions in their customer base (Col.1, lines 32-64).

(C) As per claim 5, Tarter discloses the system wherein any of the FDA and other organizations which may include pharmaceutical manufacturers and consumer organizations, may submit one or more advisories which contain information about

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interactions and side effects of medications to said advice site (The Examiner interprets health maintenance organization, preferred provider organizations, government agencies, and other entities as a form of the FDA and other organizations which may include pharmaceutical manufacturers and consumer organizations, may submit one or more advisories which contain information about interactions and side effects of medications to said advice site Col.1, lines 19-64).

(D) As per claim 6, Tarter discloses the system wherein said one or more advisories comprise:

a relevance clause which asserts the existence in a pharmacy database of customers with active prescriptions for drugs having a known, potentially damaging interaction (Col.5, lines 5-37); human readable content which tells about said interaction, tells a pharmacist he has such an interaction in this client base, and urges said pharmacist to correct the situation (Col.5, lines 5-65).

(E) As per claim 7, Tarter discloses the system wherein said advice site collects and posts said submissions (Col.5, lines 5-67).

(F) As per claim 8, Tarter discloses the system wherein one or more pharmacies subscribe to said advice site (Col.5, lines 5-17).

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(G) As per claim 9, Tarter discloses the system further comprising :
a pharmacy customer database inspector which is installed on a pharmacy computer for determining if any patients in said pharmacy database have a certain prescription (Col.18, lines 14-67 to Col.19, line 38).

(H) As per claim 10, Tarter discloses the system wherein said pharmacy computer gathers advisories routinely (Col.19, lines 9-39);
wherein relevance evaluation generates queries to said pharmacy customer database inspector (Col.21, lines 1-56);
wherein said pharmacy customer database inspector queries said pharmacy database (Col.8, lines 41-67); and
wherein relevance messages are provided by said pharmacy to appropriate pharmacy customers for dangerous drug combinations (Col.12, lines 48-67).

(I) As per claim 11, Tarter discloses wherein said advice provider comprises an advice site which operates to notify physicians about potentially damaging drug interactions in their patient base, said system further comprising (Col.1, lines 19-63):
a physician patient database inspector for those physicians who keep track of patient subscriptions on their office computers for determining if any patients in said physician

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patient database have a certain prescription (Col.1, lines 66-67 to Col.2, line 65). Tarter does not explicitly disclose the system wherein said third party is a physician is obvious. However, it is obvious to include the feature of said third party is a physician within the computerized method and system for financing health care services providers, especially pharmacies of Tartar's with the motivation of providing the means to infuse new cash into the drug distribution system and to allow pharmaceutical retailers to purchase inventory or pay down their largest payable obligations more readily (Col.59-62).

(J) As per claim 12, Tarter discloses the system wherein said third party is an individual (Col.1, lines 37-55); and

wherein said advice provider comprises an advice site which operates to notify individuals about potentially damaging drug interactions (Col.1, lines 32-64), said system further comprising :

an individual health record database inspector for those individuals who enter their own subscriptions in a user profile (Col.4, lines 8-67 to Col.5, line 53).

(K) As per claim 13, Tarter discloses the system further comprising :
an information exchange program for allowing a user to query remotely said pharmacy database for information concerning said user (Col.9, lines 29-67).

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(L) As per claim 14, Tarter discloses the system wherein said information comprises any of any condition which could be identified by specifying properties which arise singly or in combination in one or more databases, and conditions which, although not explicitly mentioned in said one or more databases, can be inferred to exist with high probability based on statistical or other inferences based on information in said one or more databases (Col.35, lines 5-65).

(M) As per claim 17, Tarter discloses the method wherein said third party comprises one or more pharmacies (Col.1, line 47).

(N) Method claims 18-19 repeats the subject matter of claims 3 and 14 and respectively as a set of means- plus-function elements rather than a series of steps. As underlying processes of claims 3 and 14 have been shown to be obvious in view of the collective teachings of Herz, Basche, Ellessen and Tarter, it is readily apparent that the system disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 18-19 are rejected for the same reasons given above for system claims 3 and 14, and incorporated herein.

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(O) Claims 22-33 repeat the subject matter of claims 3-14 and respectively as a set of "means- plus-function" elements rather than a series of steps. As underlying processes of claims 3-14 have been shown to be obvious in view of the collective teachings of Herz, Basche, Ellesson and Tarter, it is readily apparent that the system disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 22-33 are rejected for the same reasons given above for system claims 3-14 and incorporated herein.

(P) Claims 36-38 repeat the subject matter of claims 17-19 and respectively as a set of "means- plus-function" elements rather than a series of steps. As underlying processes of claims 17-19 have been shown to be obvious in view of the collective teachings of Herz, Basche, Ellesson and Tarter, it is readily apparent that the system disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 35-38 are rejected for the same reasons given above for system claims 17-19 and incorporated herein.

Response to Arguments

6. Applicant's arguments filed 01/21/04 with respect to claims 1, 15, 20 and 34 have been considered but they are not persuasive. Applicant's arguments filed on 01/21/04 have been fully considered but they are not persuasive. Applicant's arguments will be

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addressed hereinbelow in the order in which they appear in the response filed on 01/21/04.

(A) At pages 1-4, of the 01/21/04 response, Applicant's filed an Affidavit of Declaration pursuant to 37 CFR 1.131.

The Affidavit filed on 01/21/04 under 37 CFR 1.131 has been considered but is ineffective to overcome the Herz (6,029,195), Basche (6,119,164), Pant et al (6,012,053) and Grasso (5,892,909) references.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Herz (6,029,195) reference to either a constructive reduction to practice or an actual reduction to practice.

Evidence to establish diligence must be provided to cover the period just prior to 12/9/96 of (Herz) up to the filing date of the instant application. Since the declaration was insufficient, Applicant's argument directed to the rejection of the claims 1-38 used for the previous Office Action was based on the submission of the combination of the references cited above to reject the claims. Therefore, Applicant's argument is not persuasive.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:30-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

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more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

V.F
V.F

April 16, 2004

Miranda Alexander
ALEXANDER KATKUNOVSKI
Art 3626
Primary Examiner